

unpatentable over Tubesing in view of U.S. Patent No. 6,143,286 to Bhambani (*"Bhambani"*). Applicants respectfully disagree with and traverse each of these rejections for at least the following reasons.

II. 35 U.S.C. § 112, First Paragraph Rejection

Claims 19-23 and 31-40 stand rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. According to the Examiner, the specification as filed does not provide support for a "liquid detergent and conditioning cosmetic hair composition," as recited in the present claims. Final Office Action at 2. Rather, the Examiner states that the specification only provides support for "more or less thickened liquids," which the Examiner asserts are distinct from generic liquids in view of an implied difference in viscosity between "thickened" liquids and generic liquids. *Id.* at 4. Thus, the Examiner asserts that generic "liquid" detergent and conditioning cosmetic hair compositions are not supported by the specification as-filed. Applicants respectfully disagree.

35 U.S.C. § 112, first paragraph requires that the specification "describe the claimed invention in sufficient detail that one skilled in the art can reasonable conclude that the inventor has possession of the claimed invention." M.P.E.P. § 2163(I). With this in mind, there can be no argument that the "more or less thickened liquids" referred to by the Examiner are liquids nonetheless. Since such liquids are disclosed, and such disclosure is acknowledged by the Examiner, Applicants submit that the specification provides sufficient written descriptive support to allow one of skill in the art to reasonably conclude that Applicants had possession of the liquid detergent and

cosmetic hair composition, as claimed. Thus, Applicants submit that the § 112 rejection of claims 19-23 and 31-40 is improper, and should be withdrawn.

III. § 102(b) Rejection

Claims 19-23 and 31-38 stand rejected under 35 U.S.C. § 102(b) as being anticipated by *Tubesing*. According to the Examiner, example 2 of *Tubesing* (as reported at columns 7-8, Table I) anticipates the presently claimed composition. Office Action at 4-5. Applicants respectfully disagree.

To establish a rejection under 35 U.S.C. § 102, the Examiner must demonstrate that the reference teaches each and every claim limitation. See M.P.E.P. § 2141. Indeed, a claim is anticipated under § 102 only if each and every element, as set forth in the claim, is found in a single prior art reference. M.P.E.P. § 2131. Applicants respectfully submit that the Examiner has failed to meet this burden, as discussed below.

Claim 19 recites, *inter alia*, “[a] liquid detergent and conditioning cosmetic **hair** composition comprising, in a cosmetically acceptable aqueous medium: (A) **a washing base** and (B) at least one liquid ester. . . . Applicants submit the Examiner has failed to establish that *Tubesing* discloses a liquid detergent and conditioning cosmetic hair composition comprising the claimed washing base. *Tubesing* discloses a skin preparation that comprises, *inter alia*, 3% by weight of cetearyl alcohol and Ceteareth-20, 0.2% by weight of Polyquaternium-10, 1.0% by weight of Quaternium-48, and 1.0 weight % of isostearyl neopentanoate. *Tubesing*, columns 7-8, table I, example II. According to the Examiner, “Ceteareth-20 reads on the claimed detergent base or claimed nonionic surfactants of claim 38.” Final Office Action at 4. Further, the

Examiner asserts that Quaternium-48¹ “also reads on the claimed detergent base or cationic surfactants of claim 33.” *Id.* Applicants respectfully disagree.

As mentioned above, the present claims recite a liquid detergent and conditioning cosmetic hair composition comprising a washing base. In contrast to the presently claimed invention, Applicants emphasize that *Tubesing* is drawn to a skin preparation that is **resistant to being removed when the skin is washed**. *Tubesing*, column 2, lines 1-2 (emphasis added). In contrast, the present invention is directed to a liquid detergent and conditioning cosmetic hair composition. See e.g. claim 19.

A purpose of the claimed composition is to give the hair, **after rinsing**, a noteworthy treating effect. See specification, at page 3, lines 23-25. Indeed, the purpose of a washing base is to facilitate the washing/rinsing of a composition. As stated in the present specification:

It is common to use detergent compositions (such as shampoos) based essentially on standard surfactants of anionic, nonionic and/or amphoteric type . . . to clean and/or wash keratin materials such as the hair. These compositions are applied to wet hair and the lather generated by massaging and rubbing with the hands removes, after rinsing with water, the various types of soiling which are initially present on the hair.

Specification, at page 1, lines 13-22. Thus, in other words, the invention disclosed by *Tubesing* is a **skin preparation** designed to be **resistant to washing/rinsing**, whereas the presently claimed invention is a liquid detergent and conditioning cosmetic **hair**

¹ Applicants note that in the Office Action, the Examiner asserts that “Quaternium-18” falls within the scope of the claimed detergent base or cationic surfactants. This appears to be a typographical error, as the Examiner makes this reference while discussing example II of *Tubesing*, which does not contain Quaternium-18. For the purpose of this discussion, Applicants have assumed that the Examiner intended to state that Quaternium-48, which is contained within example II, falls within the scope of the claimed detergent base or cationic surfactant.

composition designed to be **removed by washing**, leaving behind a beneficial treating effect to the hair.

With this in mind, at least two differences are thus apparent between the presently claimed hair compositions and the skin preparation of *Tubesing* pointed to by the Examiner. First, the compositions of *Tubesing*, including the composition of Example II pointed to by the Examiner, are directed to **skin preparations**; in contrast, the presently claimed invention recites **hair compositions**. Second, one of ordinary skill in the art of detergent and conditioning cosmetic hair compositions would not consider the skin preparations disclosed by *Tubesing*, which are wash-resistant, to possess a washing base, as claimed. No such washing based could be present since the preparations of *Tubesing* are specifically designed to be wash-off resistant – the opposite function as the washing base as presently claimed.

Thus, Applicants submit that the Examiner has failed to establish that *Tubesing* teaches or suggests each and every one of the limitations of the present claims. Accordingly, Applicant submit that the rejection of claims 19-23 and 31-38 under 35 U.S.C. § 102(b) as being anticipated *Tubesing* is improper, and should be withdrawn.

IV. 35 U.S.C. § 103(a) Rejection

Claims 19-23 and 31-40 stand rejected under 35 U.S.C. § 103(a) as unpatentable over *Tubesing* in view of *Bhambani*. Office Action, pages 5 and 6. The Examiner, noting that *Tubesing* fails to disclose a composition comprising the amount of washing base recited in claims 39 and 40, turns to *Bhambani*. *Id.* Asserting that *Bhambani* teaches a hair treatment composition that contains similar components as the skin treatment composition of *Tubesing*, and utilizes the claimed amount of

surfactant, the Examiner concludes that it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify *Tubesing* to use the quantity of surfactant recited in *Bhambani*, so as to arrive at the claimed invention. *Id.*

According to the Examiner, one ordinary skill would have been motivated to make this modification in view of the fact that surfactants are used for cleansing purposes. *Id.*

Applicants respectfully disagree with and traverse this rejection for at least the following reasons.

To establish a prima facie case of obviousness, the Examiner must show that three basic criteria have been met. See M.P.E.P. § 2143. Specifically, the Examiner must establish:

- (1) that the prior art teaches or suggests all of the claim limitations;
- (2) that there is some teaching or suggestion in the prior art to make the modification; and
- (3) that one of ordinary skill in the art would have had a reasonable expectation of success in making the asserted modification.

Id. As shown below, Applicants respectfully submit that the Examiner has not established that there is any teaching or suggestion in the applied prior art that would have motivated one of ordinary skill to modify *Tubesing* further to the teachings of *Bhambani*, much less with the requisite reasonable expectation of success.

As discussed above, *Tubesing* discloses a **skin preparation** that is **wash-resistant**. *Tubesing*, column 2, lines 1-5. *Bhambani*, on the other hand, teaches a **shampoo** composition containing various **cleansing surfactants**. As the Examiner will appreciate, one of ordinary skill would understand that one of the primary purposes of a cleansing surfactant in a hair care composition is to bind dirt and other impurities in the

hair such that these impurities may be **washed away**. Thus, Applicants are at a loss as to why one of ordinary skill in the art would have been motivated to modify the skin preparation of *Tubesing* - which is expressly taught to be wash resistant - so as to incorporate an amount of cleansing surfactant that is disclosed be suitable for use a shampoo by *Bhambani*. Given the fact that the skin preparation of *Tubesing* is expressly disclosed to be wash resistant, and the fact that cleansing surfactants used in shampoos are designed to be rinsed out of the hair, Applicants submit that one of ordinary skill in the art would not have been motivated to combine *Tubesing* with *Bhambani* in the manner asserted by the Examiner, much less with a reasonable expectation of success.

Indeed, as the skin preparation of *Tubesing* is designed to be wash-resistant, whereas the cleansing surfactants of *Bhambani* are rinsed from the hair, Applicants submit that one of ordinary skill in the art would expect that such a combination would be detrimental to the wash-resistance of the skin-preparation of *Bhambani*. Thus, one of ordinary skill in the art, if anything, would have been led away from the asserted combination in view of the disclosure of the applied references.

For at least the reasons set forth above, Applicants submit that there is not teaching or suggestion in the applied prior art that would motivate one ordinary skill in the art at the time the invention was made to modify *Tubesing* with *Bhambani* in the manner asserted by the Examiner, much less with a reasonable expectation of success. Thus, Applicants submit that the § 103(a) rejection of claims 19-23 and 31-40 as unpatentable over *Tubesing* in view of *Bhambani* is improper, and should be withdrawn.

V. Conclusion


In view of the foregoing remarks, Applicants respectfully request reconsideration of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

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